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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 09/032,083   | 02/27/1998  | ROBERT T. BELL       | 062891.0279                     | 9496                        |
| 5073   | 7590        | 04/29/2009           |                                 |                             |
| BAKER BOTTS L.L.P.<br>2001 ROSS AVENUE<br>SUITE 600<br>DALLAS, TX 75201-2980 |             |                      | EXAMINER<br>NGUYEN, STEVEN H D  |                             |
|  |             |                      | ART UNIT<br>2419                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>04/29/2009 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com  
glenda.orrantia@bakerbotts.com

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/032,083 | <b>Applicant(s)</b><br>BELL ET AL. |  |
|                              | <b>Examiner</b><br>Steven Nguyen     | <b>Art Unit</b><br>2419            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 106-125 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 106-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/2/2009 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 120-125 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose a logic encoded in computer readable media which is executed by a processor.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 106-125 rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers (USP 5946386) in view of Amir (US 6711166).

As claims 106-109, 113-116 and 120-123, Rogers discloses a method and system comprising receiving, by a controller embodied in one or more client premises devices (Fig 1, 101 and 104 and Fig 2), an indication to initiate a communications session between a dumb terminal and a remote terminal using an Internet Protocol (IP) packet based network (Fig 1, 113 initiates a call to another user such as 106 or 118 via internet 100), the dumb terminal comprising a non-IP telephone (Fig 1, 106, col. 7, lines 57-65, col. 9-11, Sec 1.8 and 1.9 and col. 14, Sec 1.25, 1.26, 1.28 for call receiving and outgoing call); and the controller for performing a signaling conversion between different type of network by using an Internetwork Packet Exchange / Sequenced Packet Exchange (IPX/SPX) transport protocol (Col. 16-17, Sec 3); receiving, by the controller, a plurality of first packets generated at the remote terminal for presentation to the dumb terminal; translating, by the controller, the received first packets into voice information for presentation to a user of the dumb terminal; receiving, by the controller, voice activity from the user; generating, by the controller, a plurality of second packets that represent the voice activity; and transmitting, by the controller, the generated second packets to the remote terminal (Fig 2, the voice packet will be translating to a voice signal for transmitting to the telephone and translating the voice signal into a packets for transmitting to the remote terminal (Fig 1, 106 and 118 are communicated via internet). However, Rogers does not fully disclose generating, by the controller, an abstraction of at least one signaling message received

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from the dumb terminal, the abstraction of the at least one signaling message comprising a description of the at least one signaling message; and translating, by the controller, the abstraction of the at least one signaling message for presentation to the remote terminal, thereby establishing the communications session between the dumb terminal and the remote terminal, comprises a computer executing telephony software (Col. 7, lines 57-65, Fig 1, 118) using the IP packet based network. In the same field of endeavor, Amir discloses generating, by the controller (Fig 2A), an abstraction of at least one signaling message received from the dumb terminal (Fig 2A, Ref 117, 119, 42A, 44a or Fig 6, 26), the abstraction of the at least one signaling message comprising a description of the at least one signaling message (Fig 4, the signaling from dumb terminal is translated into digital before encapsulating into a packet by protocol conversion); and translating, by the controller, the abstraction of the at least one signaling message for presentation to the remote terminal (Fig 4, the signaling from dumb terminal is translated into digital before encapsulating into a packet by protocol conversion to transmit to the remote terminal 48 or translating digital signaling into analog signaling for transmitting to the dumb terminal), thereby establishing the communications session between the dumb terminal and the remote terminal comprises a computer executing telephony software (Fig 6b, 26 includes telephony software) using the IP packet based network by an Internetwork Packet Exchange / Sequenced Packet Exchange (IPX/SPX) transport protocol (Figs 2, 6-7, packet network such internet or intranet; See col. 3, line 60 to col. 4, line 60, col. 5, line 49 to col. 8, line 54 and col. 9, line 29 to col. 11, line 3 and col. 11, line 66 to col. 12, line 8 for exchanging the signaling packet for establishing communication path between the stateless and state-based client in order to convey the media packet and Fig 7); receiving, by the controller, a

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plurality of first packets generated at the remote terminal for presentation to the dumb terminal; translating, by the controller, the received first packets into voice information for presentation to a user of the dumb terminal; receiving, by the controller, voice activity from the user; generating, by the controller, a plurality of second packets that represent the voice activity; and transmitting, by the controller, the generated second packets to the remote terminal (Fig 2, the voice packet will be translating to a voice signal for transmitting to the telephone and translating the voice signal into a packets for transmitting to the remote terminal (Fig 6, 26 analog to 26 IP or h.323 are communicated via internet).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a protocol converter as disclosed by Amir into the teaching of Rogers. The motivation would have been to make the internet into a universal network and reduce the cost of a call.

As claims 110, 117 and 124, Rogers/Amir inherently disclose receiving, by a controller embodied in one or more client premises equipment devices, an indication to initiate a communications session comprises receiving an off-hook signal in response to a user indicating a desire to establish the communications session (Rogers, col. 21, lines 39 and Amir Fig 6A).

As claims 111, 118 and 125, Rogers/Amir discloses the communications session comprises a media stream (Fig 1 for Rogers or Amir Fig 1).

As claims 112 and 119, Rogers/Amir discloses the at least one signaling message comprises an indication selected from the group consisting of: a telephony off-hook event, a telephony on-hook event, a telephony button depressed event, a telephony digit dialed event, and a client registration event (Rogers, col. 21, lines 39 and Amir Fig 6A).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/27/2009

/Steven Nguyen/

Primary Examiner, Art Unit 2419